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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HUFFMAN, JULIAN D

ART UNIT PAPER NUMBER

2853

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/888,215

Applicant(s)

STEVENS, CHAD A.

Examiner

Julian D. Huffman

Art Unit

2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 March 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 8-19 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8-19 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 8, 10 and 11 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

With regards to claim 8, claim 8 does not contain any new limitations not presented in claim 1.

With regards to claims 10 and 11, the following is an excerpt from MPEP 608.01(n): If claim 1 recites a method of making a specified product, a claim to the product set forth in claim 1 would not be a proper dependent claim if the product might be made in other ways. In the instant case, the product could be made by depositing the charge before printing, or without performing the printing.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. With regards to claims 12-14, Floegel et al. disclose an electrostatic sticker print medium for use with a printer, said sticker print medium comprising:

a blank sheet of electrostatic print medium (element 12);

an electrostatic charge deposited on a side of said sticker print medium (column 3, lines 11-15);

a protective backing over said electrostatic charge on said blank sheet of electrostatic print medium (element 14);

wherein said sticker print medium is made of vinyl (column 4, lines 61-62); and

wherein said sticker print medium is transparent (column 1, lines 29-35).

4. Claims 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Longtin (U.S. 5,334,431).

Longtin discloses an electrostatic sticker print medium for use with a printer, said sticker print medium comprising:

a blank sheet of electrostatic print medium (the sticker was inherently blank before it was printed upon);

an electrostatic charge deposited on a side of said sticker print medium (column 3, lines 6-9); and

a protective backing over said electrostatic charge on said blank sheet of electrostatic print medium (fig. 1, element 20, column 1, lines 22-31);

wherein said sticker print medium is made of transparent vinyl (column 3, lines 8-10 and 15-16);

wherein the sheet is perforated to define a plurality of sticker panes (fig. 1).

5. Claims 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Chamberlain.

Chamberlain discloses an electrostatic sticker kit comprising:

a kit including:

at least one blank sheet of an electrostatic sticker print medium (column 1, lines 50-54, the sticker was blank before it was printed on); and

a charge donor other than said sticker print medium for depositing an electrostatic charge on either side of said sticker print medium after said sticker print medium has been printed with an image (column 1, line 55-column 2, line 7);

wherein said at least one blank sheet of sticker print medium and said charge donor are associated together in said kit (the sticker and the charge donor could be considered part of a kit which allows a sticker to be reliably attached to a structure);

wherein said sticker print medium is made of vinyl (column 1, lines 21-22, Koroseal is one of the most popular forms of vinyl);

wherein said sheet of print medium is perforated to define a plurality of sticker panes (column 2, lines 45-52); and

wherein said sticker print medium is transparent (column 3, lines 19-24).

6. Claim 25 is rejected under 35 U.S.C. 102(b) as being anticipated by Rubino (U.S. 4,992,121).

Rubino discloses a method comprising providing an electrostatic sticker kit, said providing an electrostatic sticker kit comprising providing a kit containing at least one

blank sheet of an electrostatic sticker medium and a charge donor, other than said sticker medium, for depositing an electrostatic charge on either side of said sticker medium (abstract), wherein said at least one blank sheet of an electrostatic sticker print medium and said charge donor are associated together to form said kit. Further the sticker medium is capable of use in a printing device and was used in such a device to produce a decorative image thereon.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Floegel et al. in view of Chamberlain.

Floegel et al. disclose a method of making a user-customized electrostatic sticker, said method comprising:

printing a user-selected image on sticker print medium (column 1, lines 13-16), said sticker print medium being of a non-conductive material on which an electrostatic charge can be maintained such that said sticker print medium functions as an electrostatic sticker (column 1, lines 56-58 and column 2, lines 30-32);

depositing an electrostatic charge on said sticker print medium with a charge donor (column 3, lines 11-14);

applying said sticker such that a side of said sticker bearing said electrostatic charge is in contact with a surface to which said sticker is applied (column 4, lines 39-40, both sides are charged); and

perforating one or more sections of said sticker print medium (column 3, lines 25-28).

Floegel et al. do not disclose depositing an electrostatic charge on said sticker print medium with a charge donor after said printing of said user-selected image, wherein said charge donor is separate from, and not a part of, said sticker print medium.

However, Chamberlain discloses depositing a charge to a print medium during mounting of the medium to a surface, wherein said charge donor is separate from, and not a part of, said sticker print medium (column 1, line 55-column 2, line 7).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an electrical charge on the medium in the manner taught by Chamberlain. The reason for performing the modification would have been to increase the strength of attraction or adhesion when mounting the medium (column 2, lines 1-2).

9. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Floegel et al. in view of Chamberlain as applied to claim 1 above and further in view of Suzuki et al. (U.S. 4,882,621).

Floegel et al. as modified by Chamberlain disclose everything claimed with the exception of reversing the image when printing it.

Suzuki et al. discloses a printing device which uses a mode setting switch (16) to enable a mirror image converting circuit (4) to perform a mirror image conversion on data from a host apparatus when transparencies are used as the recording medium, such that the image may be viewed normally after printing (column 2, lines 43-47 and column 3, lines 36-50).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Suzuki et al. into the invention of Floegel et al. as modified by Chamberlain. The reason for performing the modification would have been to enable image data to appear in the proper orientation when printing on a transparent media.

**10.** Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Floegel et al. in view of Chamberlain and Suzuki et al. as applied to claim 2 above, and further in view of Naik et al. (U.S. 5,579,446).

Floegel et al. as modified do not disclose the host computer with a printer driver performing the reversing operation of the image.

However, Naik et al. discloses a host computer which performs image processing, then sends the processed image to the printer through a printer driver (fig. 1, column 5, lines 34-41).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Floegel et al. as modified to perform the processing using a printer driver of the host computer. The reason for performing the

modification would have been to reduce the cost and complexity of the printing apparatus by performing computations using the host computer.

### ***Response to Arguments***

11. Applicant's argument that in Longtin the release liner is applied to the print medium before the stickers are printed, has been considered and is respectfully not found persuasive for the following reasons. It would be undesirable to print on the pliable vinyl material without the support of the backing, further the electrostatic charge would cause the medium to stick to parts of the printer. Floegel et al. seems to support this on column 3, lines 36-42. Further, Longtin teaches that:

"static cling labels are difficult to handle because they tend to fold and adhere to surface other than the intended application surface. The clinging ability of the labels is highly beneficial when the label is finally applied to a surface. However, this clinging ability renders cumbersome the *manufacture*, shipping, storage and handling of static cling labels. For ease of *manufacture*, shipping, storage and handling, static cling labels have in the past been applied to releasable liners" (column 1, lines 22-31).

Thus Longtin suggests printing with the backing applied to the print medium.

Applicant's argument that Rubino does not disclose a kit or a business method has been considered and is respectfully not found persuasive. Applicant provides definitions for the word "kit". The most specific of which describes a kit as "a packaged set of related materials", while the most broad definition describes a kit as "a set of

articles or implements used for a specific purpose". Applicant's disclosure does not mention packaging of the sticker print medium. Applicant's invention is concerned with user control over printing of electrostatic print medium and teaches away from purchasing the finished product from a retailer. When examining claims for patentability, claims are interpreted as broadly as is reasonable and consistent with the specification, *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Since the specification makes no mention of packaging materials into a set for sale, the term kit is considered to refer to a set of articles or implements used for a specific purpose, as this is the broadest definition which is consistent with the disclosure. Further, the MPEP provides that a kit is merely "a plurality of articles grouped together", see MPEP 2115. Similarly, the use of the phrase business method is given little weight since no mention is made in the disclosure of using the articles in a business method, nor are there any steps outlined in the claims which are not taught by the prior art. If the prior art teaches all of the steps claimed, it may be said to perform a business method, since applicant has defined what a business method is by the steps performed in the method. The use of the term business method does not impart patentability to the claims. Further, Rubino discloses a set of articles or implements used for a specific purpose, one of which may be to display information in a business (column 1, lines 10-22). Since the claimed elements of the kit are disclosed by Rubino as articles or implements used for a specific purpose, including the display of information in a business, providing the set of articles is a businesses method. Interpreting the claims in light of the specification, one would not interpret the term "kit" to refer to articles which are packaged for sale, since no

mention of this is made in the specification, and since this definition is contrary to that suggested by the MPEP. Rather one would be motivated to interpret the term kit as merely a set of articles or implements used for a specific purpose, since this definition is consistent with the disclosure. To constitute a kit, the articles merely need to be in the same room.

Applicant provides a similar argument regarding the term "kit" for the Chamberlain reference, as applied to claims 16-19. This argument is also not persuasive for the same reasons as those found above.

Applicant provides no argument for the rejection of claims 12-14 by Floegel et al. and therefore the rejection is deemed proper.

Applicant's additional arguments are directed towards subject matter presented by amendment and addressed herein under a new grounds of rejection as necessitated by the amendment.

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian D. Huffman whose telephone number is (703) 308-6556. The examiner can normally be reached on Monday through Friday from 9:30 a.m. to 6:00 p.m.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow, can be reached at (703) 308-3126. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722. Faxes requiring the immediate attention of the examiner may be sent directly to the examiner at (703) 746-4386. Note that this number will not automatically send a confirmation that the fax was received.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



JH

7 March 2003



JUDY NGUYEN  
PRIMARY EXAMINER